

Appl. No. 10/695,631
Amdt. dated December 22, 2005
Reply to Office Action of September 22, 2005

PATENT

Amendments to the Drawings:

The attached sheet of drawings includes changes to sheet 1. This sheet, which includes Fig. 1 and Fig. 1a replaces the original sheet including Fig. 1.

The detail view is re-identified as separate Fig. 1a. This is consistent with the manner in which the figure is referenced in the specification. No new matter is added with the revision of the figures.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

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REMARKS/ARGUMENTS

Claims 1-6, 12-13, 21-24, and 26-33 remain pending in the application. Applicant cancels claim 25, amends claims 1 and 24, and presents claims 1-6, 12-13, 21-24, and 26-33 for further examination, reconsideration, and allowance.

Discussion of Drawings

The detailed portion of Fig. 1 has been re-identified as Fig. 1a. This is consistent with the manner in which the figure is referenced in the specification, as filed. *See, for example*, Specification at page 3, line 5 (referring to Fig. 1a). No new matter has been added to the drawings. applicant respectfully requests withdrawal of the objections to the drawings.

Discussion of the Specification

The paragraph at page 5 lines 4-17 is amended to correct the reference to the detail view shown on sheet 1 of the drawings. The amendment corrects the language from "view 1a of Fig. 1" to --Fig. 1a--. No new matter has been added to the Specification.

Discussion of Rejections Under 35 U.S.C. §102

Claims 1, 2, 12, 26 and 27 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 799,928 to Nehr (hereinafter Nehr).

In order for a claim to be anticipated by a reference, each and every element as set forth in the claim, must be described, either expressly or inherently, in the single prior art reference.

Claim 1 includes the feature "a cutting component that is configured to a shape, the cutting component having a cutting edge and an opposing edge substantially opposite the cutting edge." Claim 1 further includes the feature "a cutting component housing that houses the cutting component, *the cutting edge and at least a portion of the opposing edge of the cutting component extending beyond the cutting component housing.*" (*emphasis added*). Support for this feature can be found throughout the Specification, for example, at Fig. 1a and the associated description at page 5 lines 5-8.

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Nehr fails to describe a cutting component within a cutting component housing, where the cutting edge and at least a portion of the opposing edge of the cutting component extends beyond the cutting component housing. Instead, as shown in Nehr Fig. 1 and detailed in Figs. 2 and 3, the cutter B has an upper edge that is entirely within the holder A. Indeed, Nehr states that "the cutter when not needed can be placed in the holder with the cutting edge innermost, thereby protecting such edge and maintaining it in a clean condition." Nehr, at Col. 1, ll. 21-25. Nehr also states: "...in use the upper edge of the cutting-ring has firm bearing against the upper wall of the recess 14." Thus, the upper edge of the cutting-ring is expressly described as contained within the housing.

Therefore, not only does Nehr fail to describe a cutting edge and opposing edge of the cutting component extending beyond the component housing, but Nehr explicitly features that one edge is maintained entirely within the housing, such that the cutter can be reversed and stored to protect its edge. Applicant respectfully requests reconsideration and allowance of claim 1, because Nehr fails to set forth every element of the claim.

Claims 2, 12, 26 and 27 depend from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

Claims 1, 2, 26-27, 29, and 31-33 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,746,104 to Russell et al. (hereinafter Russell).

As described above, claim 1 features a cutting component having a cutting edge and an opposing edge that extend beyond a cutting component housing.

These features are not described in Russell. In Russell, the cutter insert 25 does not extend beyond the socket member 23. The socket member 23 has a socket bore 33 that retains the cutter insert 25. "The socket bore 33 also has a shark end 35 having an opening which has a diameter of reduced dimension relative to the socket bore 33 so as to form an annular mounting surface 37, which abuts cutter insert 25 when it is in its seated disposition." *Russell*, at Col. 2, ll. 35-39. Therefore, Russell expressly describes the cutter insert as having one end entirely within the socket member 23, and in fact abutting an internal annular mounting surface.

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Russell does not describe "a cutting component housing that houses the cutting component, *the cutting edge and at least a portion of the opposing edge of the cutting component extending beyond the cutting component housing.*" (*emphasis added*). Therefore, Applicant respectfully requests reconsideration and allowance of claim 1, because Russell fails to describe every claimed element as set forth in the claim.

Claim 2 and 26-27 depend from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

Claim 29 includes the feature "a handle extending from the punch holding end and configured, at least in part, to limit a cutting depth of the punch die." Russell provides description of the shank portion 29 in any way limiting the cutting depth of the punch die. This claimed feature is wholly absent from Russell, and thus not anticipated by Russell. The Examiner provides a conclusory statement that this feature is described in Russell, but fails to cite any corresponding description from Russell that supports the conclusion.

Claims 31-33 depend from claim 29 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

Claims 21, 29, 30, 32, and 33 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,230,156 to Patenaude (hereinafter Patenaude). Patenaude describes a cooking utensil having an opening in a base plate to receive a food component for molding the food component. *Patenaude*, Abstract.

Patenaude is not concerned with cutting, and in fact does not even describe cutting in the entire description. Patenaude also fails to discuss any die. The cooking mold of Patenaude is not even analogous art to the claimed portable punch system. Patenaude fails to describe anything even remotely resembling a cutting die.

Thus, claims 21, 29, 30, 32, and 33 are believed to be allowable over Patenaude, because Patenaude fails to describe cutting, punch dies, or other features of the claims. Applicant respectfully requests reconsideration and allowance of claims 21, 29, 30, 32, and 33.

Claim 24 was rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,189,220 to Chen (hereinafter Chen). Claim 24 includes features similar to that described above in relation to claim 1. Claim 24 includes "a cutting component that is

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configured to a shape, the cutting component having a cutting edge and an opposing edge substantially opposite the cutting edge" and "a cutting component housing that houses the cutting component, the cutting edge and at least a portion of the opposing edge of the cutting component extending beyond the cutting component housing." Chen fails to describe these claimed features. In Chen, there is no portion of an opposing edge of a cutting component that extends beyond a cutting component housing. Thus, Chen fails to describe every claimed feature and claims 24 is believed to be allowable over Chen.

Discussion of Rejections Under 35 U.S.C. §103

Claims 3-6 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Nehr in view of U.S. Patent No. 3,250,163 to Smith (hereinafter Smith). Claims 13 and 28 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Nehr in view of U.S. Patent No. 4,388,743 to Hellinger et al. (hereinafter Hellinger).

Claim 22 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Patenaude in view of U.S. Patent No. 5,561,903 to Bourbeau (hereinafter Bourbeau). Claim 23 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Patenaude in view of Smith.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

Claims 3-6, 13, and 28 depend, either directly or indirectly from claim 1. As described above, Nehr fails to describe every feature of claim 1. Smith and Hellinger fail to describe or suggest those features of claim 1 absent from Nehr. Thus, claim 1, and claims 3-6, 13, and 28, which depend from claim 1, are believed to be allowable over Nehr and Smith, whether alone or in combination.

Claims 22 and 23 depend from claim 21. As described above, Patenaude fails to describe every feature of claim 21, and in fact, is not even analogous art to that of claim 21.

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Bourbeau fails to provide any description of cutting or punch dies, and there is no motivation or suggestion for one to look to either Patenaude or Bourbeau when dealing with portable punch systems. Thus, Patenaude and Bourbeau, whether alone or in combination, fail to teach or suggest all features of independent claim 21, and thus claim 22, which depends from claim 21, is believed to be allowable at least for the reason that it depends from an allowable base claim.

Similarly, there is no suggestion or motivation for one to attempt to combine the teachings of the cooking mold of Patenaude with a powdered metal rule die described in Smith. Further any such combination of the two references would not result in the features of claim 21. Thus, claim 21, and dependent claim 23, are believed to be allowable over Patenaude in view of Smith, because there is no motivation to combine the teachings of Patenaude with Smith, and the combination fails to teach or suggest all features of claim 21.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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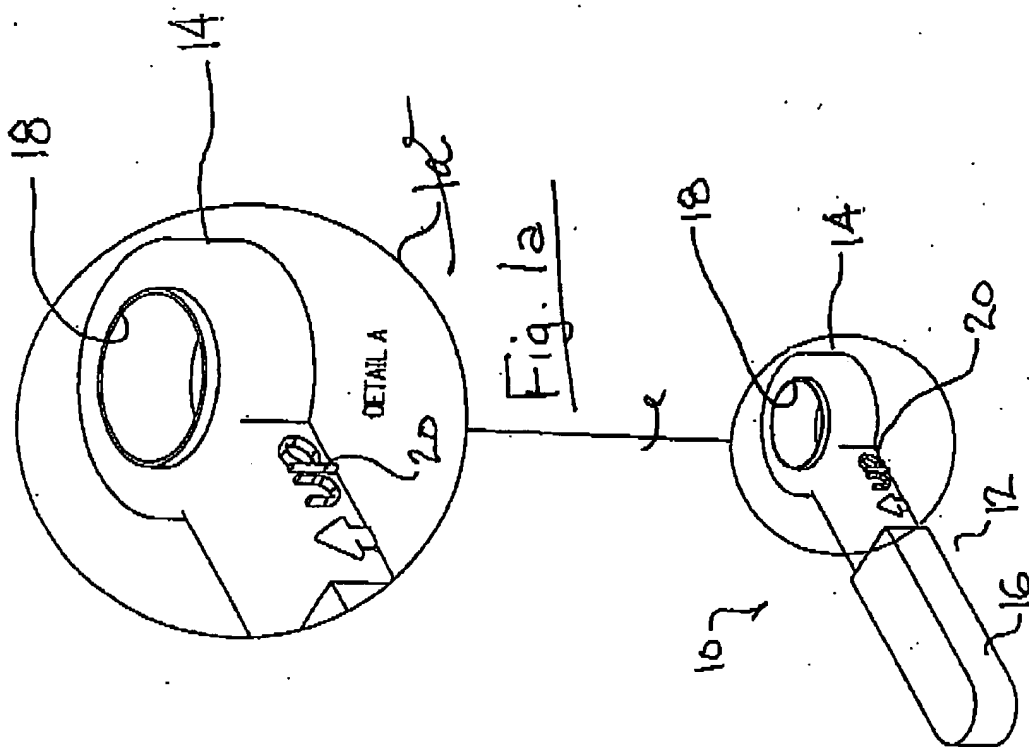


FIG. 1